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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,931	10/09/2003	Arthur Richard Metcalf	MIC-46 (P50-0118)	7750

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT PAPER NUMBER

1733

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/681,931

Applicant(s)

METCALF ET AL.

Examiner

Geoffrey L. Knable

Art Unit

1733

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.



Geoffrey L. Knable
Primary Examiner
Art Unit: 1733

Continuation of 11. does NOT place the application in condition for allowance because: principally the reasons of record. With respect to the 35 USC 112 first paragraph rejection, upon reconsideration in view of applicant's comments, it would be agreed that the indication in the specification that a "number of connections" may be provided including connection to and between batteries would indicate possession/support for the claim 1 reference to coupling at least one pair of connecting terminals. Embedding "at least a portion of at least one" of the terminals and that "at least a portion of at least one" of the terminals is secured in rubber, so that an "electric assembly may be coupled to the pair of connecting terminals outside the cured rubber" is however still not considered to reasonably supported by the original disclosure. In particular, the original disclosure would not describe embedding "at least a portion" of the connecting terminals ("at least" encompasses some OR ALL of the terminal can be embedded/secured) but then also connecting the apparently same terminals outside the rubber. In other words, as presently claimed, the terminals that are used for coupling outside the rubber have at least one terminal "at least a portion" of which is embedded/secured whereas the original disclosure does not describe this at least to this scope (i.e. there is no description of a fully embedded terminal used to couple outside the rubber). Further, while it would be agreed that the original disclosure does seem to describe some connections that would be fully embedded (e.g. between batteries), a reasonable reading of the present claim language does not seem to be referring to these connections but rather to the connecting terminals that are to be used for the external coupling. As to the prior art rejections, applicant's comments have been carefully considered but seem to attribute limitations to the present claims that are not considered to be present therein. In particular, it is argued that the modification to both Kulka et al. and Lee would require that the electronics in these references be moved outside the cured rubber, it being urged that this is "specifically called for in the claims". This argument has been carefully considered but is unpersuasive. The claims have not been read to define or limit the scope or content of the claimed "electric assembly" in a manner that would define over simply terminals provided to allow recharging. In other words, if terminals are provided, they have the capability to be coupled to any electric assembly. Further, it is not considered that the claimed patch has been in any way defined in a manner that would exclude the presence of the electronics within the cured rubber with the battery as in the primary references. These arguments are thus not considered at present to be commensurate with the scope of the present claims. Applicant has also argued that Frey et al. indicates that that the rechargeable battery can be charged by the motion of the tire and concludes that this "thus requiring NO external terminals" (emphasis in original). Nowhere do Frey et al indicate that no external terminals are required. In fact, as set forth by the examiner in the last office action, "Ko et al. further provides evidence that the artisan, even if desiring to effect recharging using tire motion (as mentioned by Frey et al.), would have found it obvious to provide such tire motion generated power in the form of externally connected devices (esp. fig. 3A)". Further, applicant's arguments with respect to Ko et al. (and especially the reference to antenna 310) are not understood. The relevant disclosure in fig. 3A is that the modules 306/330 are externally connected to the tire motion power generating means 340 - note wire(s) 342 .